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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,685	05/03/2001	Jens Hamann	A34189 (071308.0149)	7455

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BAKER BOTTS L.L.P.
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NEW YORK, NY 10112-4498

EXAMINER

MACKEY, JAMES P

ART UNIT PAPER NUMBER

1722

13

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,685

Applicant(s)

HAMANN, JENS

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11, 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 2 and 3 are objected to because of the following informalities: in the claims, "piezoelectric" has been misspelled, and should be corrected to read --piezoelectric--.

Appropriate correction is required.

2. Claims 4-6, 10 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 4, 5, 10 and 11 merely recite how the claimed structure is intended to be operated during the intended use of the apparatus; however, such relates only to the intended use of the claimed apparatus structure, which does not patentably distinguish apparatus structure and therefore does not further limit the subject matter of the apparatus claims. See *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235.

Claim 6 merely recites how the claimed structure was designed; however, such relates only to the process of making the claimed apparatus, which does not patentably distinguish apparatus structure and therefore does not further limit the subject matter of the apparatus claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-6 and 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, "arbitrarily distributed" is indefinite as to how "arbitrary" can define an apparatus structure which does not change locations of the actuators (it appears that "arbitrarily

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distributed” is intended to describe the method of constructing the apparatus, which does not patentably distinguish the apparatus itself). Similarly, the recitation “are distributed according to a desired distribution of force” in claim 3 refers only to the method of constructing the apparatus, which does not patentably distinguish the apparatus itself.

In claims 2 and 3, “between the carrier plate and closure plate” should be --between the carrier plate and the closure plate-- for proper antecedence and to clearly refer to the same closure plate as previously recited.

In claims 4 and 9, “between carrier plate and closure plate” should be --between the carrier plate and the closure plate-- for proper antecedence and to clearly refer to the same carrier plate and closure plate as previously recited.

In claim 6, lines 1-2, “a number of piezoelectric actuators required” is grammatically incorrect and apparently unnecessary, since independent claim 12 already refers to plural “actuators”.

In claim 8, “provided in any desired geometry” is unclear and indefinite as to whether this intends that the geometry may change in an apparatus once constructed; for purposes of examination, this phrase will be interpreted to mean that the distribution of the actuators corresponds to a geometric shape. Similarly, claim 15 will be interpreted as meaning that the distribution of actuators is in the shape of a rectangle.

In claim 12, lines 5-6, “a disengaging force is triggered by piezoelectric actuators” is indefinite as to which structural element receives the force, and indefinite as to what structural elements the piezoelectric actuators are attached to; in other words, the claim is incomplete for

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omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Further in claim 12, line 7, “intermediate position which executes a piezo displacement” is unclear and indefinite as to how a “position” may “execute” a displacement.

5. Claims 2, 3, 8, 9 and 12-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The prior art of record does not teach or fairly suggest a pressure-generating apparatus including a stationary support plate, a carrier plate traveling in relation to the stationary support plate and capable of being fixed in a working position, the carrier plate comprising on its side towards the stationary support plate an electromechanically disengageable closure plate which cooperates with the stationary support plate to press material or clamp tools therebetween, the closure plate capable of being fixed in at least one intermediate position, and piezoelectric actuators between the carrier plate and the closure plate for providing a disengaging force/displacement between the carrier plate and the closure plate.

While the prior art of record shows that it is known to provide a pressure generating apparatus having a moving platen movable toward and away from a stationary platen, the moving platen capable of being fixed in a working position, with piezoelectric actuators between the moving platen and an associated molding platen for displacing the molding platen relative to the moving platen and for applying a pressing force to the molding platen, the prior art of record does not teach or fairly suggest such an arrangement wherein the molding platen is capable of being fixed.

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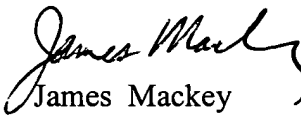
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 703-308-1195. The examiner can normally be reached on M-F, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


James Mackey
Primary Examiner
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7/14/03

jpm
July 14, 2003